

REMARKS

Favorable reconsideration of this application is requested in view of the following remarks. Claims 1 and 2 are allowed. Claim 3 is amended to correct a typographical error. Support for claim 3 can be found at least on page 18. Claims 1-3 remain actively pending in the case. No new matter has been added. Reconsideration of the claim is respectfully requested.

In paragraph 2 on page 2 of the Office Action, Claim 3 was rejected under 35 USC § 102(b) as being anticipated by Swan (US 4,832,373). Applicants respectfully traverse the rejection.

Swan fails to teach or suggest at least forming a first machine-readable indicia on an image layer on a media. The indicia in Swan merely correspond to the indicia contained on a typical page 30 of TV Guide Magazine and other television program listings. Col. 2, lines 38-42. Swan does not disclose that the print on the typical page 30 is machine-readable. The Applicants respectfully submit that the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d at 902, 221 USPQ at 1127. Applicants respectfully request that the Examiner submit an affidavit as to the Examiner's personal knowledge or submit a prior art reference suggesting the desirability of modification.

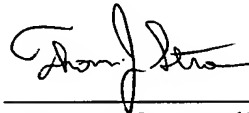
Swan also fails to teach or suggest at least forming a second machine-readable indicia in a protective substantially transparent overlayer on said image layer on said media, said second indicia being identical in content to and in registration with said first machine-readable indicia. First, as discussed above, Swan does not disclose machine-readable indicia. Second, Swan also fails to teach or suggest forming a second machine-readable indicia in a protective substantially transparent overlayer on said image layer. Rather, Swan uses a preformed overlay transparent sheet 10. *See* Fig. 1, item 10. Accordingly, Swan does not form an overlayer on a TV Guide Magazine. Also, Swan does not form a second machine-readable indicia in a protective layer. Swan merely prints

indicia and horizontal and vertical lines on the transparent sheet 10. Col. 2, lines 34-37.

Therefore, in view of the above remarks, Applicants' independent claim 3 is patentable over the cited reference.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,



Attorney for Applicant(s)
Registration No. 53,950

Thomas J. Strouse/phw
Rochester, NY 14650
Telephone: 585-588-2728
Facsimile: 585-477-4646

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.